

**Remarks:**

Applicant hereby affirms the election of invention I, claims 1-8. Claims 9-13, directed to invention II, are canceled.

Claims 7 and 8 were rejected under 35 U.S.C. §112, second paragraph, based on the allegation that "acrylic," "vinyl chloride," "vinyl acetate" and "styrene butadiene styrene" are not resins or polymers. Applicant respectfully disagrees with this allegation. The terms cited by the Examiner are in conformity with convention of referring to such compositions without stating explicitly that they are polymers. In other words, "polyacrylics," "poly(vinyl chloride)," "poly(vinyl acetate)," and "poly(styrene butadiene styrene)" are commonly referred to in industry as simply "acrylics," "vinyl chloride," "vinyl acetate" and "styrene butadiene styrene (or SBS)." The fact that they are polymers is implied. This is particularly so where, as here in the specification and claims, the compositions are explicitly referred to as polymers or resins. Nevertheless, in an effort to be extra-clear on the matter, claims 7 and 8 have been amended to identify the compositions as resins. Accordingly, withdrawal of the rejections of claims 7 and 8 under 35 U.S.C. §112, second paragraph is respectfully requested.

Claim 2 has been rejected under 35 U.S.C. §112, second paragraph, based on the allegation that "claims 2 recites the broad recitation 'rubber particles', and the claim also recites 'waste rubber buffings and ground tires' which is the narrower statement of the range/limitation." This allegation is not understood. The point of a dependent claim and of a restrictive clause is to be narrower than the claim from which the dependent claim depends and the object of what the restrictive clause restricts. Nevertheless, it is believed that the amendment to claim 2 should obviate whatever concern the Examiner has with the claim. Accordingly, withdrawal of the rejections of claim 2 under 35 U.S.C. §112, second paragraph is respectfully requested.

Claims 1-7 have been rejected under the judicially created doctrine of obviousness-type double patenting in view of U.S. patent 5,910,514 and claim 8 has been rejected under the same doctrine in view of that patent in view of the Byrne patent. A terminal disclaimer is enclosed. It is believed that the terminal disclaimer obviates those rejections and so their withdrawal is respectfully requested.

Favorable reconsideration is requested of the rejection of claims 1-6 as obvious over the Byrne patent. There is no disclosure or suggestion of the particles called for in claims 1-6. The Byrne patent discloses a pad. In fact, the object of the Byrne patent is to provide a pad. The claims are directed to pads. The specification is directed to pads. Even the title is directed to pads. Byrne even goes to great lengths, even incorporating a binder, to form a pad as opposed to particles. The Patent and Trademark Office, however, cannot use a prior art teaching in such

a way that the prior art invention "would be rendered inoperable for its intended purpose." *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). To arrive at the present claimed invention from the Byrne patent, the ordinarily skilled artisan would have to produce particles instead of a pad—even going so far as eliminating the binder taught by Byrne—in contradiction of Byrne's teachings. Because this would destroy the intended purpose of the Byrne invention, the rejection is improper. Accordingly, withdrawal of the rejection of claims 1-6 is respectfully requested.

In view of the foregoing, it is believed that the application is now in condition for allowance and favorable reconsideration and early allowance of claims 1-8 are earnestly solicited.

Respectfully submitted,



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